

REMARKS

Entry of the foregoing amendments is requested prior to consideration of this application on the merits. After of the April 20, 2005 Final Office Action, claims 1-3 and 5-20 were pending and had been rejected as allegedly being unpatentable over U.S. Patent No. 4,795,171 to Lindae et al. (“Lindae”) or U.S. Patent No. 6,416,210 to Uchida (“Uchida”). By a July 6, 2005 Amendment After Final, Applicant sought to amend claims 1, 3, 5-7, 9-10, 17-18 and 20 and to cancel claim 14 (without prejudice or disclaimer). Applicant sought entry of these amendments as being directed to formal matters (e.g., changing “arrangement” in claim 1 to “protuberance” to conform to previous amendments), and as simplifying or reducing matters for appeal (e.g., amending claim 5 into independent form and canceling claim 14). A July 27, 2005 Advisory Action indicated that these amendments would not be entered, however, since they were believed by the Examiner to require further search.

To gain entry of the previously submitted amendments, as well as to add new claims 21 and 22, Applicant now submits the present preliminary amendment. New claim 21 recites, *inter alia*, the modified surface regions of claim 20 “are produced on at least one of the first and second side parts of the exit surface of the lens.” New claim 22 recites, *inter alia*, the modified surface regions of claim 21 “are produced on both the first and second side parts of the exit surface of the lens.” Support for these amendments is found throughout the application as originally filed, including for example on pages 10-11 and Figure 4. No new matter will be added to this application by entry of these amendments. Entry is respectfully requested.

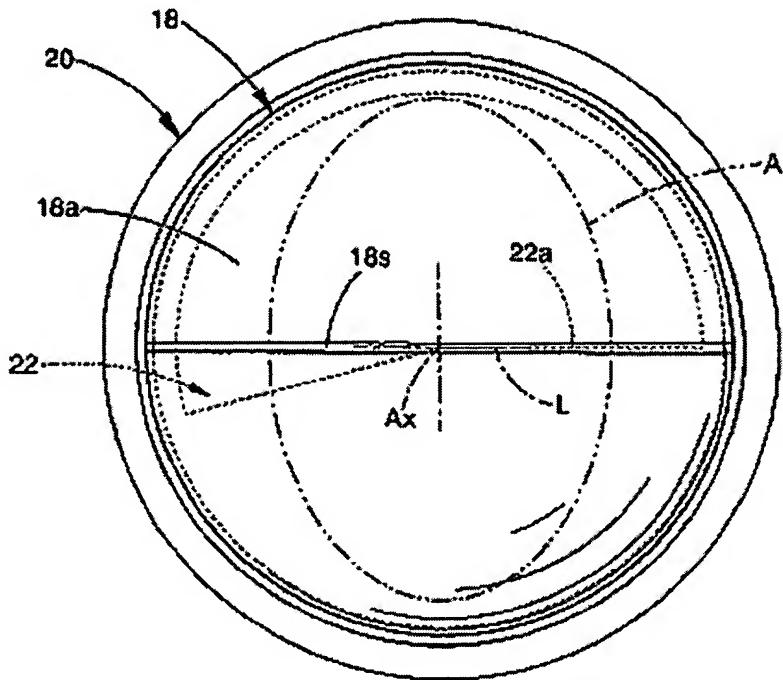
Applicant earnestly asserts that pending claims 1-3, 9-14 and 19-22 differ from the disclosures of Uchida and Lindae. These claims recite that the protuberances or surface modified regions are “produced solely on the side parts of the exit surface of the exit lens.” As

defined in these claims, these first and second side parts are “laterally disposed on opposing sides” of “a central part... which encompasses a region of the exit surface intersected by a vertical plane defined by an optical axis of the projection device.”

The April 20 office action had not alleged that Uchida anticipated or rendered obvious previously pending claim 14 (“wherein the protuberances are produced solely on these side parts”) or claim 20 (“the modified surface regions being produced on at least one of the side parts of the exit surface of the lens”). Thus, the office action conceded that Uchida does not teach, disclose or suggest a headlamp with an exit lens having protuberances solely on side parts of the exit surface as recited in pending claim 1.

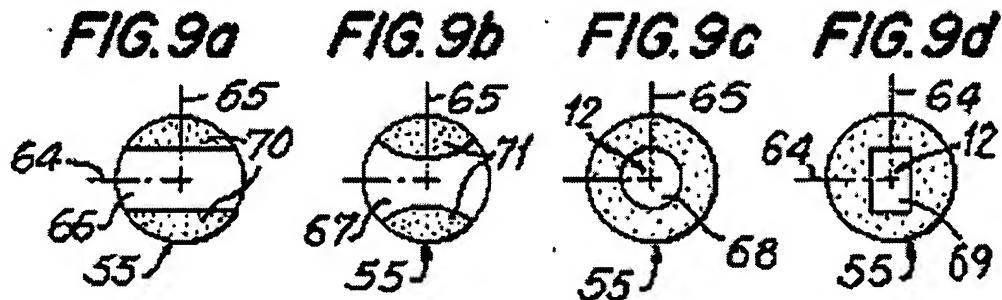
Indeed, Uchida discloses that his lens elements (18s), which the prior office action alleged correspond to Applicant’s protuberances, “extend in the horizontal direction along a line of intersection L between the front-side surface 18a and a horizontal plane including the optical axis Ax of a lighting appliance.” [Uchida, Col. 4, Ins. 28-31] This is shown in Uchida’s Figure 4:

FIG. 4



As depicted above, the lens element 18s extends into the transmitted-light passage region A, which encompasses optical axis as Ax at its center. Thus, Uchida's lens elements 18s are not "produced solely on the side parts of the exit surface of the exit lens" as recited in Applicant's claims 1 and 20.

As to Lindae, the prior office action has relied on Figures 9A to 9D, which show different modifications of objective 55 of Lindae's Figure 6. That office action suggested that these Figures (reproduced below) show protuberances on side parts of the exit surface, but not having protuberances on a central part:



In each of these figures, a smooth partial surface (66 through 69) is shown which does *not* disperse the passing light beam. [Lindae, Col. 4, Ins. 47-50]. Although not expressly stated, microelements (58), which the office action argued correspond to our claimed protuberances, are provided outside of these smooth partial surfaces on the objective 55. Vertical plane (65) is shown running through the central portions (66 to 69) as well as the surface portions having microelements (58). The office action appears to believe that these smooth partial surfaces correspond to the “central part” of Applicant’s claim 1 and 20.

As best understood, the prior office action argued that central portions (68 and 69) of Figures 9c and 9d would correspond to Applicant’s claimed “central part,” and the partially shaded remainder of the objective (55) could then be divided along the vertical central plane (65) into “first and second part parts” as in Applicant’s pending claims.

However, this suggestion does not comport with the language of the pending claims. In particular, claim 1 recites, *inter alia*, that the central part “encompasses a region of the exit surface intersected by a vertical plane defined by an optical axis of the projection device.” As shown in the figures 9a-9d reproduced above, Lindae’s central portions (66, 68, 68 and 69) do not encompass the region intersected by such a vertical plane. To the contrary,

Lindae's figures show vertical plane (65) running through the central portions (66 to 69) as well as the surface portions having microelements (58). Thus, Lindae also fails to teach, disclose or suggest "protuberances being produced solely on the side parts of the exit surface of the exit lens" as recited in Applicant's claims 1 and 20.

Applicant also earnestly asserts that pending claims 5 and 15-16 differ from the disclosures of Uchida and Lindae. The previously office action conceded the novelty of these claims, because Lindae and Uchida fail to teach, disclose or suggest protuberances with "a thickness of between 0.2 millimeters and 3 millimeters" as recited in Applicant's claim 5. Nonetheless, the prior office action asserted that these claims allegedly were obvious over Lindae or Uchida. In particular, April 20, 2005 Office Action stated its belief that the thickness feature was an obvious optimization of a range:

"It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify thickness of a protuberance, since it has been held that where the general conditions of a claim are disclosed in the prior art, *discovering the optimum or workable ranges involves only routine skill in the art.* *In re Aller*, 105 USPQ 233." (4/20/05 Office Action at p. 6) (emphasis added).

The office action is correct that the U.S. Court of Customs and Patent Appeals (CCPA) established the rule that the discovery of an optimum value of a variable in a known process *normally* is obvious. See *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). However, as with many rules, there are exceptions to the CCPA's rule. One exception is where the parameter allegedly being optimized was not recognized to be a "result-effective variable." See, e.g., *In re Yates*, 663 F.2d 1054, 1057, 211 USPQ 1149, 1151 (CCPA 1981). Likewise, the Manual of Patent Examination Procedure (MPEP) § 2144.05 (at 2100-143) permits such an "optimization" rationale only when the references themselves recognize that the variable (here

thickness) is a result effective variable. See, e.g., *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (cited at MPEP § 2144.05, at 2100-143). In *Antonie*, the claimed wastewater treatment device recited a tank volume to contractor area of 0.12 gal./ft². That claimed device was held to be patentable over the prior art, because the prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio. That being the case, a person of ordinary skill in the art would not understand the need or benefit of optimizing that claimed parameter. In other words, the burden remains with the office action to show that variable in question is "known to be result effective." *In re Antonie*, 559 F.2d at 621, 195 USPQ at 9.

Here, our review of Linda and Uchida finds no such disclosure or understanding that would motivate a person of ordinary skill in the art to optimize protuberance thickness. To the contrary, Linda's microelements (58) appear to be superficial pits or imperfections that are introduced into the lens soften the sharp dark/light line. [Linda, 4/17-27]. Thickness of the microelements is not discussed in Linda. Likewise, Uchida discloses that his lens elements (18s) can have any "cross-sectional shape" and "vertical width." [Uchida, 1/64-67]. Neither Linda nor Uchida recognizes thickness to be of any importance. Thus, the determination of thickness cannot be an obvious expedient because the art fails to appreciate that thickness is a result effective variable, and the office action's optimization rationale is inapplicable.

Thus, the subject matter of Applicant's claims 5 and 15-16 is patentability distinct from Linda and Uchida.

Applicant has chosen in the interest of expediting prosecution of this patent applicant to distinguish the cited documents from the pending claims as set forth above. These statements should not be regarded in any way as admissions that the cited documents are, in fact, prior art. Likewise, Applicant has chosen not to swear behind Uchida cited by the office action

at this time. Applicant, however, reserves the right, as provided for pursuant to 37 C.F.R. § 1.131, to do so in the future as appropriate.

Finally, Applicant has not specifically addressed the rejections of the dependent claims. Applicant respectfully submits that the independent claims, from which they depend, are in condition for allowance as set forth above. Accordingly, the dependent claims also are in condition for allowance. Applicant, however, reserves the right to address such rejections of the dependent claims in the future as appropriate.

CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 1948-4808.

Dated: August 9, 2005

By:

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.



Matthew K. Blackburn
Registration No. 47,428

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101
(212) 415-8700 Telephone
(212) 415-8701 Facsimile